



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,787	12/24/2003	Toshihiro Maeda	009683-490	9816
21839 7590 03/10/2008 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
EXAMINER				
WON, MICHAEL YOUNG				
ART UNIT		PAPER NUMBER		
2155				
NOTIFICATION DATE		DELIVERY MODE		
03/10/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/743,787

Applicant(s)

MAEDA, TOSHIHIRO

Examiner

MICHAEL Y. WON

Art Unit

2155

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed December 28, 2007
2. Claim 14 has been cancelled and new claim 16 has been added.
3. Claims 1-13, 15 and 16 have been examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 8-13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnard et al. (US 2003/0005097).

INDEPENDENT:

As per **claim 1**, Barnard teaches a recording medium recording a print control program causing a computer to execute the steps of:

detecting a change in an IP address of a printing device connected to a network (see page 1, [0014]: "changes in printing device addresses... are updated"), and

after said change in the IP address is detected, searching for said printing device over the network, using information specific to said printing device (see page 1, [0012]: "detecting the printing device by sending a request message to a plurality of network addresses and receiving a response message from the printing device").

As per **claim 8**, Barnard teaches a printing device, comprising:

a detector detecting a change in an IP address (see page 1, [0014]: "changes in printing device addresses... are updated"),

a recorder recording a past IP address as specific information when said change in the IP address has been made (see page 1, [0014]: "changes in printing device addresses... are updated"), and

a responder retrieving said recorded past IP address upon an inquiry from an external device and making a response (see page 1, [0012]: "detecting the printing device by sending a request message to a plurality of network addresses and receiving a response message from the printing device located at one of the network addresses").

As per **claim 9**, Barnard teaches a recording medium recording a print control program causing a computer to execute the steps of:

determining whether or not it is possible to establish communications with a printing device connected to a network and preset to be available for the

Art Unit: 2155

communications (see page 8, [0072]: "when the identification information, of a print queue is modified, client workstations on the network will no longer be able to send print jobs to the modified print queue until their connections have been updated"),

when it is determined impossible to establish the communications, transmitting a command (see page 2, [0035]: "input configuration information and other commands and instructions") for obtaining information specific to said printing device on the network to search for said printing device (see page 3, [0042]: "Discovery module 84 is a module which is used to perform discovery on detected printing devices on network 10 so as to obtain information regarding a printing device's network setting"), and

identifying an IP address of said printing device based on the information specific to said printing device included in a response to said command (see page 6, [0055]: "identify all network devices connected to the network and assigned IP address").

As per **claim 13**, Barnard teaches a method for print control, comprising the steps of:

detecting a change in an IP address of a printing device connected to a network (see page 1, [0014]: "changes in printing device addresses... are updated"), and

after said change in the IP address is detected, searching for said printing device over the network, using information specific to said printing device (see page 1, [0012]: "detecting the printing device by sending a request message to a plurality of network addresses and receiving a response message from the printing device").

As per **claim 15**, Barnard teaches a method for print control, comprising the steps of:

determining whether or not it is possible to establish communications with a printing device connected to a network and preset to be available for the communications (see page 8, [0072]: “when the identification information, of a print queue is modified, client workstations on the network will no longer be able to send print jobs to the modified print queue until their connections have been updated”),

when it is determined impossible to establish the communications, transmitting a command (see page 2, [0035]: “input configuration information and other commands and instructions”) for obtaining information specific to said printing device on the network to search for said printing device (see page 3, [0042]: “Discovery module 84 is a module which is used to perform discovery on detected printing devices on network 10 so as to obtain information regarding a printing device's network setting”), and

identifying an IP address of said printing device based on the information specific to said printing device included in a response to said command (see page 6, [0055]: “identify all network devices connected to the network and assigned IP address”).

DEPENDENT:

As per **claim 2**, which depends on claim 1, Barnard further teaches wherein the information specific to said printing device is information of said printing device other than a MAC address, and includes at least one of a name, a specific ID, a former IP address (see page 7, [0067]: “previous IP address”), and a network port number of said printing device.

As per **claim 3**, which depends on claim 1, Barnard teaches further causing the computer to execute the step of judging whether the IP address of said printing device has been changed (see page 1, [0014]: “changes in printing device addresses... are updated”) or said printing device is powered off.

As per **claim 4**, which depends on claim 1, Barnard further teaches wherein the searching step includes the step of conducting a search by broadcasting when there is no DHCP server on the network (see page 5, [0048]: “DHCP server 75 is disabled to prevent addressing conflicts and discovery module 84 conducts classic discovery... include, but not limited to, known techniques such as using broadcast discovery messages”).

As per **claim 5**, which depends on claim 1, Barnard teaches further causing the computer to execute the step of notifying another device on the network of new information about said printing device when said printing device has been found in the searching step (see page 8, [0073]: “print queue service module 83 identifies client workstations connected to network...”).

As per **claim 6**, which depends on claim 5, Barnard teaches further causing the computer to execute the step of providing the notice again when the notifying step fails (see page 9, claim 13: “published to the network according to a set of predetermined rules”).

As per **claim 10**, which depends on claim 9, Barnard further teaches wherein setting for the communications with said printing device is updated with said identified IP address (see page 1, [0014]: “changes in printing device addresses... are updated”).

As per **claim 11**, which depends on claim 9, Barnard further teaches wherein information specific to said printing device stored in a memory is updated with the obtained information specific to said printing device (see page 1, [0014]: "changes in printing device addresses... are updated").

As per **claim 12**, which depends on claim 9, Barnard further teaches wherein said command is transmitted when it is determined that there is no DHCP server on the network (see page 5, [0048]: "DHCP server 75 is disabled to prevent addressing conflicts and discovery module 84 conducts classic discovery... include, but not limited to, known techniques such as using broadcast discovery messages").

As per **claim 16**, which depends on claim 1, Barnard further teaches wherein the computer that executes the program steps is configured to initiate print commands (see page 10, claim 26)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard et al. (US 2003/0005097) in view of Machida (US 6,195,514).

As per **claim 7**, which depends on claim 1, Barnard teaches further causing the computer to execute the step of automatically updating printer port setting based on

information obtained by performing the searching step or new information about said printing device transmitted from another device.

Machida teaches automatically updating printer port setting based on information obtained by performing the searching step or new information about said printing device transmitted from another device (see col.19, lines 35-37).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Barnard in view of Machida so that the step of automatically updating printer port setting based on information obtained by performing the searching step or new information about said printing device transmitted from another device is executed. One would be motivated to do so because Barnard teaches that of updating connection information (see page 8, [0072]).

Response to Arguments

6. Applicant's arguments filed December 28, 2007 have been fully considered but they are not persuasive.

With respect to the argument regarding claims 1 and 13, the applicant(s) argue that Barnard does not disclose the features of the recited claims. Specifically, the applicant(s) argue that the citation of paragraph [0012] does not teach "detecting a change in the IP address". Contrary to this argument, the examiner cited paragraph [0014] in the previous office action, and maintains this position in this office action, to explicitly teach this limitation. In paragraph [0014], Barnard teaches "In addition, **changes in printing device addresses** or print queue identification information are

Art Unit: 2155

updated" (emphasis added). Clearly one of ordinary skill in the art concurs that if changes are updated than changes must be inherently detected. For this reason, this limitation is explicitly taught.

With respect to the argument regarding claim 8, the applicant(s) argue that Barnard does not disclose the features of the recited claims. Specifically, the applicant(s) argue that the citation of paragraph [0014] relates to print queues and does not refer to a printing device. In paragraph [0014], Barnard teaches "In addition, **changes in printing device addresses** or print queue identification information" (emphasis added). Asserting one teaching and ignoring another is improper. For this reason, the rejection with respect to claim 8 is maintained.

With respect to the argument regarding claims 9 and 15, the applicant(s) argue that Barnard does not disclose the features of the recited claims. Specifically, the applicant(s) argue that the reference does not teach the limitations of the recited claims. In response, the applicant(s) arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The applicant(s) are encouraged to refer to the specific citations referenced by the examiner to form a basis for the arguments rather than arguing against figures and paragraphs not cited by the examiner to specifically teach the limitation.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. See *In re Hyatt*, 211 F.3d

1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Furthermore, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. See *In re American Academy of Science Tech Center*, F.3d 2004 WL 1067528 (Fed. Cir. May 13, 2004)

Conclusion

7. For the reasons above claims 1-13, 15 and 16 remain rejected and pending.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2155

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL Y. WON whose telephone number is (571)272-3993. The examiner can normally be reached on M-Th: 10AM-8PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Won/

Primary Examiner

February 26, 2008

Application Number**Application/Control No.**

10/743,787

Examiner

MICHAEL Y. WON

**Applicant(s)/Patent under
Reexamination**

MAEDA, TOSHIHIRO

Art Unit

2155